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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,753	06/11/2001	Jose-Luis Abad-Peiro	CH919980004US1 (590.059)	6136
35195 7590 06/16/2008 FERENCE & ASSOCIATES LLC 409 BROAD STREET PITTSBURGH, PA 15143				
EXAMINER TINKLER, MURIEL S				
ART UNIT 3691		PAPER NUMBER		
MAIL DATE 06/16/2008		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/787,753

**Applicant(s)**

ABAD-PEIRO ET AL.

**Examiner**

MURIEL TINKLER

**Art Unit**

3691

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)

Paper No(s)/Mail Date: 2/22/07

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This application has been reviewed. Claims 1-4, 7, 10, 13, 16 and 17 have been amended. Claims 1-20 are pending.

### ***Response to Arguments***

1. Applicant's arguments filed February 21, 2008 have been fully considered but they are not persuasive. The Applicant argues that: the 35 USC 101 Rejection of claims 2, 3, and 18 should be withdrawn because the independent claims are not subject to a 35 USC 101 Rejection; Rowney does not disclose a trusted third party that is not the merchant; and, the amended claims overcome the prior art because they include the use of a certified third party and the identity of the user need not be revealed to the merchant.
2. Regarding the argument of improper 35 USC 101 rejections of claims 2, 3, and 18, the Examiner disagrees. Claims 2, 3 and 18 are rejected under non-statutory subject matter. Specifically; claim 2 uses the term 'insurance products of insurance companies', which is non-statutory because it is the functionality (steps performed) of the interface that characterizes the invention (i.e. an interface performs the same functionality with read as prior art); claim 3 uses the terms 'companies seeking employees' and 'persons seeking employment', which is non-statutory because it is the tasks performed that characterizes the invention (i.e. any merchant or user performing the same task will read as prior art); claim 18 uses the term, 'wherein the remote site is

an airport', which is non-statutory because the location of the remote site is irrelevant (i.e. if another remote site performs the same function than it will read as prior art).

3. Regarding the argument that, Rowney does not disclose a trusted third party that is not the merchant and the argument that, the amended claims overcome the prior art because they include the use of a certified third party and the identity of the user need not be revealed to the merchant, the Examiner disagrees. Rowney discloses that a trusted and certified third-party payment gateway is known in the art in column 1 (line 37) through column 2 (line 6).

#### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 2, 3 and 18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention is directed to a judicial exception to 35 U.S.C. 101 (i.e., an abstract idea) and is not directed to a practical application of such judicial exception (e.g., because the claim does not require any physical transformation and the invention as claimed does not produce a useful, concrete, and tangible result). For claim 2, the use of insurance products versus other products is non-functional. For claim 3, the use of merchants as employees and users seeking employment is non-functional. For claim 18, the use of an airport as the remote site is non-functional.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Rowney et al. (US 5,987,140), hereafter referred to as Rowney.

8. Regarding claims 1, 16, 17, 19 and 20, Rowney discloses:

- a. A computerized method for securely transacting electronic commerce in an insecure network in the Abstract
- b. Operating between a user and merchants, where user has commercial relationship with certified trusted third party in column 1 (line 37) through column 2 (line 6)
- c. Utilizing a network link between the user and trusted third party and merchants in figure 1B
- d. Utilizing a communication protocol (SSL) on network link in column 2 (lines 7-42)
- e. Utilizing a payment protocol (SET) which is more secure than the communications protocol in column 1 (line 37) through column 2 (line 6)

- f. Authentication using a certificate improving security of communications protocol in column 1 (line 37) through column 2 (line 6) and column 11 (lines 14-17).
9. Regarding claims 2 and 18, Rowney discloses a terminal interface in figure 1A (element 38).
10. Regarding claim 3, Rowney discloses a trusted third party in column 1 (line 37) through column 2 (line 6).
11. Regarding claims 4 and 6, Rowney discloses the information in claim 1. Rowney also discloses: permitting users to access a third party in column 2 (lines 7-42); a browsing tool for gathering formation, presenting an interactive window and allowing a user to choose competitive products in column 2 (lines 7-42); transmitting payment orders and paying a merchant in the Abstract; the use of the JAVA protocol in column 4 (lines 20-31); and, using JAVA applets in column 9 (lines 33-50).
12. Regarding claim 5, Rowney discloses providing confirmation of payment (the payment capture response) in figure 13F (element 925).
13. Regarding claims 7, 9, 10 and 12, see the rejection(s) of claims 1, 4 and 5 above.
14. Regarding claims 8 and 11, see the rejection(s) of claims 7 and 6 above.
15. Regarding claims 13 and 15, Rowney discloses receiving a request from a trusted third party for information in figure 4 and column 12 (lines 13-24) and establishing a trusted third party via an authentication/certificate in column 11 (lines 14-17). See also the rejection(s) of claims 1, 4 and 5 above.
16. Regarding claim 14, see the rejection(s) of claims 6 and 13 above.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MURIEL TINKLER whose telephone number is (571)272-7976. The examiner can normally be reached on Monday through Friday from 6:30 AM until 3 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571)272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3691

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. T./

Examiner, Art Unit 3691

/Hani M. Kazimi/

Primary Examiner, Art Unit 3691